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U.S. Application No. 09/923,320 Examiner NGUYEN Art Unit 2154  
Response to December 2, 2005 Office Action

### **REMARKS**

In response to the Office Action dated December 2, 2005, the Assignee respectfully requests reconsideration based on the above claim amendments and the following remarks. The Assignee respectfully submits that the pending claims distinguish over the cited documents of record.

Claims 1, 3-48, and 51-54 are pending. The United States Patent and Trademark Office (the "Office") rejects claims 1, 20, 30, 40, 42, and 48 under 35 U.S.C. § 112, second paragraph, for antecedent basis. Claims 1, 7-20, 24-30, 34-40, 42, 44, and 46-48 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,564,261 to Gudjonsson *et al.* Claims 3-4, 21-22, 31-32, and 45 were rejected under 35 U.S.C. § 103 (a) as being obvious over Gudjonsson in view of U.S. Patent 6,021,433 to Payne *et al.* Claims 5-6, 23, 33, 41, 43, and 51-54 were rejected as being obvious over Gudjonsson in view of U.S. Patent 6,763,384 to Gupta *et al.* The Assignee shows, however, that the pending claims are patentably distinguishable over Gudjonsson, Payne, and Gupta, whether considered alone or in any combination.

#### **Rejection of Claims under 35 U.S.C. § 112**

The Office rejects claims 1, 20, 30, 40, 42, and 48 under 35 U.S.C. § 112, second paragraph, for antecedent basis. The Office takes issue with "the" number of users, as recited in the claims. In effort to address the Examiner's concerns, the independent claims have all been amended to recite "*monitoring a total number of users who log in to a website*" and "*comparing the total number of users to notification criteria of the offline user.*" The pending claims thus fully comply with 35 U.S.C. § 112, second paragraph.

#### **Rejection of Claims under 35 U.S.C. § 102 (e)**

The Office rejects claims 1, 7-20, 24-30, 34-40, 42, 44, and 46-48 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,564,261 to Gudjonsson *et al.* A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v.*

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*Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). See also DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P."). As the Assignee shows, the pending claims are patentably distinguishable over *Gudjonsson*. The patent to *Gudjonsson et al.* does not anticipate the claims, so the Assignee respectfully requests that Examiner Nguyen remove the 35 U.S.C. § 102 (e) rejection.

The pending claims are not anticipated. The pending claims recite, or incorporate, features not disclosed by *Gudjonsson*. All the independent claims, for example, recite "monitoring a total number of users who log in to a website" and "comparing the total number of users to notification criteria of the offline user." The notification criteria specifies a particular number of users that log in to the website. "When the total number of users exceeds a preset amount," then a notification is sent to the offline user. The notification informs the offline user of an amount of activity in the website. Support for such features may be found at least at paragraphs [0022], [0024], [0026], [0051], [0065], [0067], and [0092]. Claim 1, for example, is reproduced below, and all the other independent claims recite similar features.

1. (Currently Amended) A method for notifying an offline user, the method comprising the steps of:

monitoring a total number of users who log in to a website;  
as each user logs in, comparing the total number of users to notification criteria of the offline user, the notification criteria specifying a particular number of users that log in to the website; and

when the total number of users exceeds a preset amount, then sending a notification to the offline user,

wherein the notification informs the offline user of an amount of activity in the website.

*Gudjonsson* does not anticipate the claims. Examiner Nguyen is correct — *Gudjonsson* provides presence notifications for a buddy list. Yet *Gudjonsson* fails to disclose "monitoring a total number of users who log in to a website" and "comparing the total number of users to

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*notification criteria of the offline user.” “When the total number of users exceeds a preset amount,”* then a notification is sent to the offline user. Because *Gudjonsson* fails to disclose at least these features, the patent to *Gudjonsson et al.* cannot anticipate the pending claims. The Assignee, then, respectfully requests that Examiner Nguyen remove the 102 (e) rejection.

The dependent claims are likewise not anticipated. The dependent claims incorporate the same distinguishing features of their respective base claims. The Assignee, then, respectfully requests that Examiner Nguyen remove the 102 (e) rejection of the dependent claims.

**Rejection of Claims under 35 U.S.C. § 103 (a)**

Claims 3-4, 21-22, 31-32, and 45 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Gudjonsson* in view of U.S. Patent 6,021,433 to Payne *et al.* Claims 5-6, 23, 33, 41, 43, and 51-54 were rejected as being obvious over *Gudjonsson* in view of U.S. Patent 6,763,384 to Gupta *et al.* If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) the Examiner must identify “some suggestion or motivation...to modify the reference”; 2) the Examiner must identify “a reasonable expectation of success”; and 3) “the prior art reference must teach or suggest all the claim limitations.” DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8<sup>th</sup> Edition) (hereinafter “M.P.E.P.”). The Assignee shows, however, that any proposed combination of *Gudjonsson*, *Payne*, and *Gupta* still fails to teach or suggest all the features recited in the independent claims.

The pending claims are not obvious. All the pending claims recite, or incorporate, features not taught or suggested by *Gudjonsson*, *Payne*, and *Gupta*. All the independent claims, for example, recite “*monitoring a total number of users who log in to a website*” and “*comparing the total number of users to notification criteria of the offline user.*” The notification criteria specifies a particular number of users that log in to the website. “*When the total number of users exceeds a preset amount,*” then a notification is sent to the offline user. The notification informs the offline user of an amount of activity in the website. The patents to *Gudjonsson et al.*, *Payne*

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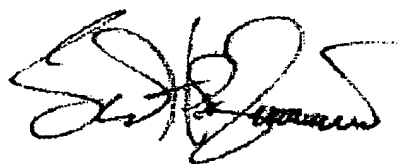
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*et al.*, and Gupta *et al.* are completely silent to such features. One of ordinary skill in the art, then, would not think the claims are obvious over any combination of these patents. The *prima facie* cases for obviousness must fail, so the Assignee respectfully requests removal of the § 103 (a) rejections.

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If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or [scott@wzpatents.com](mailto:scott@wzpatents.com).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott P. Zimmerman', written over a horizontal line.

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